

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 08/594,983 Confirmation No.: 4234
Patent No. : 5,748,740
Issue Date: May 5, 1998
Applicant(s) : Curry et al
Title : Method, Apparatus, System and Firmware for Secure Transactions
Group Art Unit : 3642
Examiner : Bernard E. Gregory
Docket No. : 20661-457

MAIL STOP PETITION
COMMISSIONER FOR PATENTS
P.O. BOX 1450
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October 26, 2010

**STATEMENT BY STEVEN R. GREENFIELD IN SUPPORT OF THE 37 CFR 1.137
PETITION TO REVIVE U.S. PATENT NO. 5,748,740**

I, Steven R. Greenfield, hereby state:

1. I reside at 5408 Blackhawk Dr., Plano, Texas, 75093 and have personal knowledge related to the Petition to Revive U.S. Patent No. 5,748,740 (hereinafter the “740 Patent”). I am currently an attorney and partner at Howison & Arnott, LLP, an intellectual property law firm located in Dallas, Texas. I am registered to practice before the United States Patent and Trademark Office with registration number 38,166.

2. Between the years 1999 and 2005, I practiced as an attorney and shareholder in the intellectual property group at the law firm of Jenkins & Gilchrist LLC (hereinafter “Jenkins”), located in Dallas, Texas. During the same time, I was responsible for certain patents and patent applications assigned to Dallas Semiconductor Corporation (hereinafter “Dallas”) and, due to a merger between Dallas and Maxim Integrated Products (hereinafter “Maxim”), certain patents and patent applications assigned to Maxim.

3. Dallas merged with Maxim on or about April 11, 2001. As part of the merger, Dallas assigned certain patents and patent applications, including the '740 Patent, to Maxim.

4. Jenkins was responsible and obligated to manage, docket and track patent maintenance fee due dates and payments for all Dallas/Maxim patents managed by Jenkins. Jenkins was also responsible for requesting instructions or an authorization from Dallas and/or Maxim to pay patent maintenance fees for all Dallas/Maxim patents managed by Jenkins.

5. Jenkins had a patent maintenance fee payment procedure in place for U.S. patents assigned to Dallas or Maxim that were managed by Jenkins. I was familiar with the Dallas/Maxim maintenance fee payment procedure.

6. To the best of my recollection, Jenkins' patent maintenance fee payment procedure used for U.S. patents assigned to Dallas or Maxim that were managed by Jenkins was substantially as follows:

- a. When a U.S. patent Issue Notification document was received from the U.S. Patent and Trademark Office (hereinafter "USPTO"), the first (3 ½ year) patent maintenance fee due date was docketed into Jenkins' Master Data Docket System (hereinafter the "Docket System")
- b. The Docket System calculated a patent maintenance fee reminder date. A patent maintenance fee reminder date is a date used to remind a Jenkins attorney to contact Dallas/Maxim by letter or email and request instructions or an authorization from Dallas/Maxim to pay the upcoming maintenance fee for the particular patent.
- c. The patent maintenance fee reminder date was set to remind a Jenkins attorney to send a letter/email to Dallas/Maxim requesting instructions or an authorization to pay the patent maintenance fee about six (6) months prior to the 3 ½ year maintenance fee due date (without surcharge).
- d. After an initial letter/email was sent to Dallas/Maxim requesting authorization to pay a maintenance fee, the Docket System was updated

to look for an authorization or instruction from Dallas/Maxim a preset number of days prior to the maintenance fee due date.

- e. Additional reminder letters/emails were sent and sometimes phone calls were made by Jenkins attorneys to Dallas/Maxim when timely instructions or a maintenance fee payment authorization was not timely received by Jenkins from Dallas/Maxim.
- f. It was understood by Jenkins, Dallas and Maxim that if no authorization to pay a maintenance fee was received by Jenkins from Dallas/Maxim, then Jenkins would not pay the U.S. patent maintenance fee for particular patent.

7. I recently reviewed various pertinent maintenance fee related documents from the '740 Patent's tri-fold file.

8. The '740 Patent issued on May 5, 1998. The '740 Patent tri-fold file shows that this event was docketed and that the first (3 ½ year) patent maintenance fee due date (without surcharge) was also docketed.

9. The first patent maintenance fee for the '740 Patent was due by November 5, 2001. Thus, a letter/email from Jenkins requesting authorization to pay the maintenance fee for the '740 Patent should have been sent to Dallas/Maxim about six (6) months earlier, being between about May 5, 2001 and about May 20, 2001.

10. As indicated above in paragraph 3, Dallas and Maxim merged on or about April 11, 2001, which is just prior to the time frame when the letter/email requesting maintenance fee payment authorization should have been sent by Jenkins.

11. Commencing after the merger between Dallas and Maxim, all the tri-fold patent and patent application files affected by the merger had to physically go through Jenkins' docketing personnel to have pertinent changes of address, assignments and other information manually entered/docketed into the Docket System. It is important to understand that the general rule at Jenkins, in this particular type of situation, was that the whole tri-fold file rather than just individual documents from a tri-fold fold went to docketing personnel for data/docket entry. This general rule was followed so that individual documents were kept with their tri-fold files to minimize document

misplacement or loss. It is my best recollection that this docketing process of the merger affected files took from about five (5) to about ten (10) months to complete due, at least in part, to the ebb, flow and continuing activity of the active patent applications involved.

12. Based on my best recollection of how Dallas/Maxim patent files were managed at Jenkins and on my review of certain documents from the '740 Patent tri-fold file, it appears that Jenkins' patent maintenance fee payment procedure broke down and the requisite letter/email requesting authorization to pay the '740 Patent's maintenance fee, which should have been sent to Dallas/Maxim, was never sent. Further based on my best recollection of the situation, it appears that the requisite letter/email was never sent because the '740 patent tri-fold file was caught up in and/or misplaced due to the ebb and flow of the many, many Dallas/Maxim physical tri-fold files being stored and moved around on file carts through the manual procedure of entering pertinent information and USPTO filing information into the Docket System associated with the then recent merger of Dallas and Maxim.

13. Review of the '740 Patent's tri-fold file further supports a break down in Jenkins patent maintenance fee payment procedure. Jenkins docketed the '740 Patent's maintenance fee due date, but no letter or email was sent from Jenkins to Dallas (prior to the April 11, 2001 merger date) or to Maxim (after the merger date) requesting instructions or an authorization to pay the first patent maintenance fee for the '740 Patent, which is completely inconsistent with the normal Jenkins patent maintenance fee payment procedure for Dallas/Maxim. Furthermore, there is no correspondence in the '740 Patent's tri-fold file from either Dallas or Maxim providing instructions or authorizing payment of the first maintenance fee. Without authorization to pay the maintenance fee (or any other instructions) from Dallas/Maxim prior to the November 5, 2001 due date, Jenkins was not supposed to pay the maintenance fee to the USPTO. As such, the '740 Patent's maintenance fee was not paid while Dallas/Maxim had no knowledge that a maintenance fee was due or an opportunity to decide whether the maintenance fee should be paid.

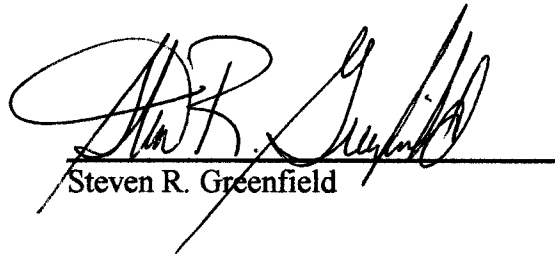
14. Therefore, it is my best estimation based on my recollection of how Dallas/Maxim patent files were managed at Jenkins and on my review of certain documents from the '740 Patent tri-fold file, that the delay in payment of the '740 Patent's

first maintenance fee was unavoidable, since reasonable care was taken by Jenkins to insure that the maintenance fee would be paid, but was not paid because the patent maintenance fee payment procedure in place at Jenkins broke down and failed in this instance to request instructions or an authorization to pay the maintenance fee from Dallas/Maxim.

15. In August 2005, I left Jenkins and joined my present firm, Howison & Arnott, LLP.

16. In March 2007, Jenkins disbanded. It is my understanding that the Maxim patents and patent applications managed by Jenkins were transferred to the law firm of North, Webber & Baugh, LLP, located in Palo Alto, California.

Respectfully submitted,



Steven R. Greenfield

Date: October 26, 2010